

Applicants : Maureen J. Charron and Ellen B. Katz  
Serial No. : 09/886,954  
Filed : June 21, 2001  
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#### REMARKS

Claims 1-35 were pending in the subject application. Claims 24-35 were withdrawn from consideration by the Examiner as drawn to nonelected subject matter. By this Amendment, applicants have canceled claims 21-35 without prejudice or disclaimer and amended claims 1 and 11. Accordingly, upon entry of this Amendment, claims 1-20 as amended will be pending and under examination.

Applicants maintain that the amendments to claims 1 and 11 do not raise an issued of new matter. Support for the amendments to claims 1 and 11 can be found *inter alia* in the specification as originally filed on page 6, lines 15-16. Accordingly, applicants respectfully request that the Amendment be entered.

#### Oath or Declaration

On page 2 of the Office Action, the Examiner indicated that the oath or declaration appears to be defective because it does not identify priority to U.S. Application no. "09/516,214," filed March 1, 2000.

Applicants respectfully point out that the subject application claims priority to U.S. Patent Application No. 09/516,493, filed March 1, 2000, and not to U.S. Application no. "09/516,214." Further, in order to claim the benefit of the filing date of an earlier filed copending application under 35 U.S.C. §120, the later filed application must contain a specific reference to the earlier filed application. The first paragraph of the subject application recites that "[t]his application is a continuation-in-part of copending U.S. Patent Application No. 09/516,493, filed March 1, 2000, the entire contents of which are expressly incorporated by reference herein." There is no requirement under 35 U.S.C. §120 that the Declaration of the later filed application contain a reference to the earlier filed application. In addition, although 37 C.F.R. §1.63 does require that a Declaration list a foreign application for which a claim for priority is made, there is no requirement under 37 C.F.R. §1.63 that the Declaration list

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an earlier filed U.S. patent application. Finally, U.S. Patent Office Declaration Form PTO/SB/01 does not provide a space to list an earlier filed U.S. patent application. Accordingly, reconsideration and withdrawal of this objection to the previously filed Declaration is respectfully requested.

#### Objection to Claim 21

On page 3 of the Office Action, the Examiner objected to the wording of claim 21. Applicants have hereinabove canceled claim 21 rendering this objection moot.

#### Rejections under 37 C.F.R. 112, First Paragraph

On page 3 of the Office Action, the Examiner rejected claims 21-23 under 35 U.S.C. §112, first paragraph, for lack of enablement.

Applicants have hereinabove canceled claim 21-23 rendering this rejection moot.

#### Rejections under 35 U.S.C. §102(a)

On page 7 of the Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. §102(a) as anticipated by Rogers et al. (WO 99/18125).

Applicants have hereinabove amended claim 1 to recite "A method for determining whether a subject has a defect in cell proliferation, comprising assaying a diagnostic sample of the subject for GLUTx expression, wherein detection of GLUTx expression elevated above normal is diagnostic of a defect in cell proliferation and wherein GLUTx protein comprises the amino acid sequence set forth in Genbank accession number XP\_011828." A copy of Genbank accession number XP\_011828 is attached hereto as **Exhibit 1**. Applicants maintain that Rogers et al. (WO 99/18125) do not teach the amino acid sequence set forth in Genbank accession number XP\_011828 and thus Rogers et al. do not anticipate the claimed subject matter.

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Accordingly, applicants request that the Examiner reconsider and withdraw this ground of rejection.

#### Rejections under 35 U.S.C. §103(a)

On page 9 of the Office Action, the Examiner rejected claims 11-20 under 35 U.S.C. §103(a) as obvious over Rogers et al. (WO 99/18125).

Applicants have hereinabove amended claim 11 to recite "A method for assessing the efficacy of therapy to treat a defect in cell proliferation in a subject who has undergone or is undergoing treatment for a defect in cell proliferation, comprising assaying a diagnostic sample of the subject for GLUTx expression, wherein detection of GLUTx expression elevated above normal in the diagnostic sample is indicative of a need to continue therapy to treat the defect in cell proliferation, and normal GLUTx expression in the diagnostic sample is indicative of successful therapy, and wherein GLUTx protein comprises the amino acid sequence set forth in Genbank accession number XP\_011828." Applicants maintain that Rogers et al. (WO 99/18125) do not teach or suggest the amino acid sequence set forth in Genbank accession number XP\_011828 and thus Rogers et al. do not render obvious the claimed subject matter. Accordingly, applicants request that the Examiner reconsider and withdraw this ground of rejection.

#### Supplemental Information Disclosure Statement

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants would like to direct the Examiner's attention to the references which are listed on form PTO/SB/08A-B attached hereto as **Exhibit 2** and which were previously cited in connection with U.S. Serial No. 09/516,493, from which the subject application claims priority under 35 U.S.C. §120. Accordingly, pursuant to 37 C.F.R. §1.98(d), copies of such previously cited references are not included with this Information Disclosure Statement.

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Applicants are submitting the subject Information Disclosure Statement pursuant to 37 C.F.R. §1.97(c)(2) before the mailing of any of a Final Office Action under 37 C.F.R. §1.113, a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in the application. A check for \$180.00 is enclosed to cover the fee for submitting an Information Disclosure Statement pursuant to 37 C.F.R. §1.97(c)(2).

#### CONCLUSION

In view of the amendments and remarks made hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the objections and rejections set forth in the January 9, 2003 Office Action and earnestly solicits allowance of the claims under examination, namely claims 1-20.

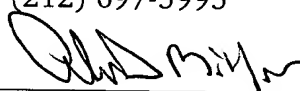
No fee, other than the enclosed \$180.00 fee for submitting an Information Disclosure Statement, is deemed necessary in connection with the filing of this response. However, if any additional fee is required to preserve the pending of the subject application, authorization is hereby given to charge any such fee to Deposit Account No. 01-1785. Overcharges may be credited to Deposit Account No. 01-1785.

Respectfully submitted,

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Dated: April 1, 2003  
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